REMARKS

Claims 1-8 are pending and under consideration.

I. REJECTION UNDER 35 U.S.C. § 103

Claims 1-8 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Han *et al.* (U.S. Patent No.6,339,113, the '113 patent) in view of Huang *et al.* (U.S. Patent No. 4,966,934, the '934 patent). Further, Claims 1-8 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Han *et al.* (U.S. Patent Application Publication No. US 2002/0072551, the '551 application) in view of Huang *et al.*. Yet further, Claims 1-8 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Han *et al.* (U.S. Patent No.6,573,312, the '312 patent) in view of Huang *et al.* In particular, the Examiner alleges that compositions comprising bis-GMA, tri-GMA and tetra-GMA, disclosed in the '113 patent, the '551 application and the '312 patent in combination with the '934 patent render compositions instantly claimed obvious. This rejection is traversed. Reconsideration is respectfully requested.

Applicants respectfully submit that U.S. Patent Application Publication No. US 2002/0072551 issued on June 3, 2003 as U.S. Patent No. 6,573,312. The '312 patent and the '113 patent have a common inventor with the subject application. To support this fact, Applicants have attached hereto a statement under 35 U.S.C. § 103(c), evidencing the common ownership of the two cited patents and the instant application (*see*, MPEP 706.02(I)(2)II), and copies of the Assignment documents filed in connection with the two patents. Accordingly, the '312 patent and the '113 patent do not qualify as prior art under 35 U.S.C. § 103 (a), rendering the rejection of claims 1-8 moot, as the '934 patent is irrelevant, if viewed alone. Therefore, it is respectfully requested that the rejection be withdrawn.

II. NONSTATUTORY DOUBLE PATENTING

A. U.S. Patent No. 6,339,113 in view of Huang *et al.*

Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-24 of U.S. Patent No. 6,339,113 in view of Huang *et al.* (U.S. Patent No. 4,966,934). Without acquiescing in the rejection and in order to expedite prosecution, Applicants submit a Terminal Disclaimer. It is respectfully requested that the rejection be withdrawn in view of the Terminal Disclaimer and fee filed herewith.

B. U.S. Patent No. 6,573,312 in view of Huang *et al.*

Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-16 of U.S. Patent No. 6,573,312 in view of Huang *et al.* (U.S. Patent No. 4,966,934). Without acquiescing in the rejection and in order to expedite prosecution, Applicants submit a Terminal Disclaimer. It is respectfully requested that the rejection be withdrawn in view of the Terminal Disclaimer and fee filed herewith.

C. U.S. Patent Application Serial No. 09/749,878 in view of Huang *et al.*

Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-24 of co-pending application Serial No. 09/749,878 in view of Huang *et al.* (U.S. Patent No. 4,966,934). Applicants respectfully submit that the application Serial No. 09/749,878 issued as U.S. Patent No. 6,573,312 on June 3, 2003. Accordingly, we refer to the part B, section II of the instant response.

D. U.S. Patent Application Serial No. 10/699,117 in view of Huang *et al.*

Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-12 of co-pending application Serial No. 10/699,117 (the '117 application) in view of Huang *et al.* (U.S. Patent No. 4,966,934).

Obviousness-type double patenting is a judicially created doctrine intended to prevent improper timewise extension of the patent right by prohibiting the issuance of claims in a second patent which are not "patentably distinct" from the claims of a first patent. *See In re Braat*, 19 U.S.P.Q.2d 1289, 1291-92 (Fed. Cir. 1991).

Applicants respectfully submit that claims 1-12 of the '117 application are patentably distinct from Claims 1-8 of the instant application. Claims 1-12 of the '117 application recite a two-component dental composition, while the instant invention claims a one-component dental system. For this only reason, the two sets of claims are patentably distinct. Additionally, the composition as claimed recites among the ingredients of the dental system a hydrohilic monomer and a photoinitiation system, which are absent in the composition recited in the '117 application. As such, claims 1-12 of the '117 application do not recite each and every limitation of the instantly claimed composition, as legally required to establish a *prima facie* case of obviousness (*See, In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974), MPEP 2143.03).

The '934 patent is not a prior art, as discussed in Section I of the response. Nevertheless, it does not remedy the deficiencies of the '117 application. The '934 patent recites a one-component dental composition comprising bis-GMA, an adhesive monomer, a photoinitiating system and a HEMA (hydroxyethyl methacrylate). Nothing in the claims of the '934 patent suggests or motivates a skilled artisan to introduce a photoinitiating system into the two-component system of the '117 application to arrive at the composition as instantly claimed. Nor they teach or suggest adding of the hydroxyethyl methacrylate into the composition disclosed in the '117 application, as an adhesive is already present in the composition. Therefore, the '117 application in combination with the '934 patent did not provide a reasonable expectation of success needed for an obviousness based rejection. *See In re Dow*, 5 U.S.P.Q.2d 1529, 1531-1532 (Fed. Cir. 1988).

Therefore, Applicants respectfully submit that claims 1-8 are not obvious over claims of the '117 application in view of claims of the '934 patent. Applicants respectfully request that this provisional rejection is held in abeyance until the case is allowed.

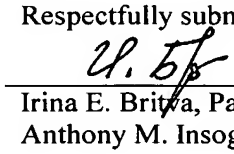
CONCLUSION

In light of the above remarks, Applicants respectfully request that the Patent Office consider this application with a view towards allowance.

No fees, other than the Terminal Disclaimer fee, are believed to be due. However, the Commissioner is hereby authorized to charge any required fee(s) to Jones Day Deposit Account No. 50-3013 (referencing Attorney Docket No. 8111-034-999).

Respectfully submitted,

Date: June 16, 2005



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